

AMENDMENTS TO THE DRAWINGS

Fourteen amended drawing figures are attached following the last page of this paper. In the final Office Action of October 5, 2006, the Examiner states that the drawings submitted on September 30, 2003 and July 25, 2006 are unreadable due to the small font size and unreadable drawing symbols. The Applicant hereby submits fourteen (14) replacement drawings to correct this deficiency. The Applicant submits that no new matter has been introduced by the attached replacement drawings.

REMARKS / ARGUMENTS

The present application includes pending claims 1-32, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0093485, issued to Dougall et al. (hereinafter,

Dougall), in view of U.S. Publication No. 2002/0166123, issued to Schrader et al. (hereinafter, Schrader). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the

apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Dougall and Schrader Does Not Render Claims 1-32 Unpatentable

The Applicant turns to the rejection of claims 1-32 as being unpatentable over Dougall in view of Schrader. The Applicant notes that the proposed combination of Dougall and Schrader forms the basis for all of the pending rejections.

**A. The Proposed Combination Does Not Teach or Suggest
"Transferring a Storage Unit From a First Location to a Second
Location" (*First Claim Limitation*)**

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Dougall and Schrader does not disclose or suggest at least the limitation of "storing media and metadata ... on a storage unit ... at a first location and if said storage unit is transferred to a second location and coupled to a second communication device at said second location ... presenting ... a channel guide," as claimed by the Applicant in independent claim 1. More specifically, *Dougall does not teach storing media and meta data associated with the media on a **storage unit** coupled to a communication device at a first location, and transferring the storage unit to a second location and coupling it to a second communication device at the second location.* In the Final Office Action, the Examiner states the following:

Regarding Claim 1, 11, and 21, Dougall teaches porting information between locations in a communication network[0034], the method comprising: storing media along with meta data associated with said stored media on a storage unit coupled to a communication device at a first location; if said storage unit is transferred to a second location and coupled to a second communication device at said second location, presenting a channel guide comprising representations of said stored media on a television [0061][0069] in said second location [0129][0023]; and in response to receiving a selection via said presented channel guide[0129], displaying at least one media file corresponding to said received selection on at least one of said television and a media player in said second location[0023].

See the Final Office Action at page 3. The Applicant respectfully disagrees with the Examiner's argument. The Applicant points out that the Examiner has cited paragraphs 0061, 0069, 0129, and 0023 of Dougall in support of the First Claim Limitation. Paragraph 0061 of Dougall discloses a general network architecture of Figure 1, and paragraph 0069 discloses a router node 230 and client nodes 240. Paragraph 0129 of Dougall discloses providing of service announcements by the session manager 820, and paragraph 0023 discloses delivery of best-efforts data and real-time data. It is unclear what the Examiner is referring to by citing paragraphs 0061, 0069, 0129, and 0023 of Dougall since *none of these paragraphs disclose or suggest the limitation of "storing media and metadata ... on a storage unit ... at a first location and if said storage unit is transferred to a second location and coupled to a second communication device at said second location ... presenting ... a channel guide,"* as claimed by the Applicant in independent claim 1. In fact, **neither Dougall nor Schrader disclose or suggest a storage unit or any other device that is coupled to a first communication device at a first location and, if transferred, the same storage unit is now coupled to a second communication device at a second location.**

Additionally, the Examiner states in the Final Office Action (page 3) that Dougall does not teach the limitation of "based on said meta data associated with

said storage media on said transferred storage unit," as called for in independent claim 1. The Applicant respectfully agrees.

Accordingly, the proposed combination of Dougall and Schrader does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is, therefore, allowable at least for the above reasons.

**B. The Proposed Combination Does Not Teach or Suggest
"Displaying Based On Said Meta Data ... On Said Transferred
Storage Unit, At Least One Media File ... On Said Television ...
In Said Second Location" (Second Claim Limitation)**

With regard to the rejection of independent claim 11 under 103(a), the Applicant submits that the combination of Dougall and Schrader does not disclose or suggest at least the limitation of "displaying based on said meta data ... on said transferred storage unit, at least one media file ... on said television ... in said second location," as recited by the Applicant in independent claim 1.

The Examiner refers for support to paragraph 0023 of Dougall. Paragraph 0023 of Dougall discloses delivery of best-efforts data and real-time data. Neither Dougall nor Schrader discloses storing of media and meta data on a storage unit at a first location, and, if the storage unit is transferred to a second location, displaying a media file on a TV in the second location **based on the meta data on the transferred storage unit.**

Accordingly, the proposed combination of Dougall and Schrader does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is, therefore, allowable at least for the above reasons. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the proposed combination of Dougall and Schrader at least for the reasons stated above with regard to claim 1.

C. Rejection of Dependent Claims 2-10, 12-20 and 22-32

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Dougall in view of Schrader has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20 and 22-32 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-32.

CONCLUSION

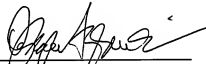
Based on at least the foregoing, the Applicant believes that all claims 1-32 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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Ognyan Beremski, Esq.
Registration No. 51,458
Attorney for Applicant

McANDREWS, HELD & MALLOY, LTD.
500 WEST MADISON STREET, 34TH FLOOR
CHICAGO, ILLINOIS 60661
(312) 775-8000

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